

REMARKS

In an office action dated 28 January 2005, the Examiner objects to and rejects claim 9 (only pending claim). In to the Office Action, Applicant amends claim 9 and respectfully traverses the rejection. Claim 9 (only pending claim) remains in the Application. In light of the following arguments, Applicant respectfully requests that claim 9 and the Application be allowed.

Applicants have amended claim 9 to correct the informalities cited by the examiner and other typographical errors. No new matter has been entered from these amendments and the scope of claim 9 has not changed.

In the office action, the Examiner rejects claim 9 as being unpatenable under 35 U.S.C. §103(a) over U.S. Patent Number 6,721,754 issued to Hurst et al. (Hurst) in view of U.S. Patent Number 6,665,682 issued to Dekimpe et al. (Dekimpe). In order to maintain a rejection the Examiner has the burden of providing evidence of prima facie obviousness. See MPEP §2143. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, and a teaching of each and every claimed element. Id. The Examiner has failed to provide a teaching of each and every element of the claims and a proper motivation to combine the references.

Amended claim 9 recites the use of a one-dimensional list and a multi-dimensional list in generating a join graph. Hurst does not teach the limitations of inserting tables into the proper list. Instead, Hurst teaches a concept of a fuzzy similarity join to form join graphs in a manner particularly useful in chemical research and development. See Col. 5, line 9-Col. 6, line 11. While Hurst does teach the concept of creating a join graph, Hurst does not teach the use of a one-dimensional list and a multi-dimensional list as recited in the claims. In fact, the Examiner cites mere discussions of dimensions in Hurst as teaching the inserting of tables into a list. See, Col 5, lines 44-66, Col. 11, lines 15-44, and Col. 16, lines 3-59. Applicant has read the entirety of Hurst and cannot not find a reference to a method for determining a dimensionality of table or inserting the table in lists of one-dimensional or multi-dimensional tables. In short, while Hurst may teach a method for generating a join graph, Hurst does not teach the method recited in claim 9.

Dekimpe also does not teach the use of list in creating a join graph as recited in amended claim 9. Instead Dekimpe teaches a method for storing tables in a relational

database. Applicant has read the entirety of Dekimpe and finds no mention of creating join graphs. Thus, there is not mention of inserting table into list and using lists as recited in amended claim 9.

Since neither Hurst nor Dekimpe teaches the limitations of using lists to form join graphs, the combination of these reference cannot teach the limitations. Thus, applicants respectfully request that the rejection of claim 9 be removed and amended claim 9 be allowed.

Furthermore, even if the combination teaches all of the limitations of amended claim 9, the Examiner has not provided a proper motivation to combine the references. See MPEP §2143. The Examiner is reminded that for a combination to be proper the proposed modification or combination cannot change the principle mode of operation of reference. See MPEP §2143.01. See also In re Ratti, 270 F2d. 810 (CCPA 1959).

The Examiner has made the mere assertion that the use of dimensions would have been motivation to combine the references. However, the use of such would change the principle mode of operation of either device. Hurst operates perfectly fine to use fuzzy similar join to get the desired join graphs needed. There is no need to modify the method as it works properly on its own to provide similar principles of the invention. Dekimpe is a method for storing information and there is no need in Dekimpe for the forming of join graphs as taught in Hurst. Thus, the Examiner has improperly combined these references. The Examiner has used improper hindsight to merely find Dekimpe that uses the terms used by Applicants and to add Hurst teachings of making join graphs. For this reason, the rejection cannot be maintained. Therefore, Applicant respectfully requests that amended claim 9 be allowed.

If the Examiner has any questions regarding this response or the Application in general. The Examiner is invited to telephone the undersigned at 775-586-9500.

Respectfully submitted,
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